

Application No. 09/138,807

Amendment dated January 5, 2004

Reply to Office Action of November 5, 2003

### REMARKS

In the Office Action dated November 5, 2003, claims 2-4, 11 and 16-18 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kenner et al. (U.S. Patent No. 5,956,716, hereinafter "Kenner") in view of Kapoor (U.S. Patent No. 5,751,969, hereinafter "Kapoor"). Further, claims 12-15 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Mao et al. (U.S. Patent No. 6,459,427, hereinafter "Mao") in view of Kapoor. Claim 10 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Kenner, in view of Kapoor and in further view of Official Notice. Claims 5-9 and 19-23 were indicated as including allowable subject matter. In this response to rejection, independent claims 11 and 16 have been broadened by amendment. New claim 24 has been added, which includes subject matter similar to that previously found in claim 11.

#### Claim Rejections

Independent claims 11 and 16 were rejected as being obvious over Kenner in view of Kapoor. Claim 11 has been broadened by amendment to call for tracking a (video) transmission after a first marker, the tracking on-going from the point in time when the first marker is transmitted. Kenner and Kapoor both fail to disclose or suggest an on-going tracking from the point in time when a first marker is transmitted.

Generally, Kenner describes an audio/video clip storage and retrieval system, which distributes video clips to various servers in different regions. Column 5, lines 42-54. If the demand for a clip within a region is high, the clip is stored within that region. Column 27, lines 44-54. However, clips that are in low demand for a region may be stored in a different region. *Id.* To test the response time for a remote storage and retrieval unit (SRU), communications links may be tested. Column 27, lines 54-61. For example, testing is a combination of factors, one being the round-trip elapsed time for a test packet. *Id.* Kenner fails to disclose how a round-trip elapsed time for a test packet is determined. As such, amended claim 11 is not obvious over

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Kenner in view of Kapoor. To establish a *prima facie* case of obviousness, all of the claim limitations must be taught or suggested. MPEP § 2143.03.

Likewise, Kapoor fails to disclose or suggest an on-going tracking of a video transmission from the point in time when a first marker is transmitted. For example, in Kapoor one node may set a bit in a data packet before transmitting that data packet to the next node. Column 4, lines 52-55; column 5, lines 7-9. That is, the node merely sets the bit and sends the data packet with the set bit. There is no suggestion that the node tracks the transmission of the data packet after the bit is set. As such, Kapoor fails to disclose all of the limitations of amended claim 11. Because neither Kenner nor Kapoor, alone or in combination disclose all of the limitations of amended claim 11, amended claim 11 is not obvious in view thereof.

Claim 16 has also been amended. As amended, claim 16 recites "track the transmission after said first marker, said tracking on-going from the point in time when the first marker is transmitted." For at least the reasons explained with respect to amended claim 11, amended claim 16 is not obvious over Kenner in view of Kapoor.

Original independent claim 12 calls for a counter that tracks a transmission from the point where the first marker was inserted. As explained above, Kapoor's node that sets a congestion indicator bit is not described as tracking the transmission of the data packet after the bit is set. Further, Kapoor's counter counts data packets post transmission, after being received at a second node. Kapoor at column 5, lines 46-49. Moreover, Kapoor's counter is merely incremented upon receipt of an indicated data packet in an all or none manner. *Id.* Thus, Kapoor fails to teach or suggest a counter that tracks a transmission from the point where the first marker is inserted. As such, a *prima facie* case of obviousness has not been established with respect to claim 12.

Claim 2 was rejected on the basis that it is inherent that web content disclosed by Kenner can be accompanied by television broadcasts. To be inherent, the missing descriptive matter necessarily must be present in the thing disclosed in the reference M.P.E.P. § 2163.07(a). The

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possibility that a thing may occur falls short of inherency. *Id.* As such, it is respectfully submitted that the Examiner has not met his burden for establishing inherency. Likewise, this burden has not been met with respect to claim 17.

With respect to claims 3 and 18, it is respectfully submitted that Kenner fails to disclose combining a web broadcast content with television programming and transmitting the combined broadcast. If anything, Kenner teaches away from combining web content and television programming. For example, Kenner dissociates audiovisual content from a Web page for distributed storage. Column 5, lines 42-53. The dissociated video clips are transferred to the user's browser. Column 25, lines 7-9. Thus, for at least this reason, a *prima facie* case of obviousness has not been established with respect to claims 3 and 18. Similarly, a *prima facie* case of obviousness also has not been established with respect to claim 4.

Claim 10 was rejected over Kenner, Kapoor and Official Notice. This rejection is respectfully traversed. Claim 10 calls for reporting a transmission to a log-in server and allowing a third party to access the log-in server to receive transmission reporting. It is believed that Official Notice is inappropriate in this case and that authority for the statement made in the Office Action should be produced. Furthermore no suggestion or motivation to modify Kenner or Kapoor in view of the alleged Official Notice has been provided. Thus, a *prima facie* case of obviousness has not been established with respect to claim 10.

New claim 24 includes subject matter similar to claim 11 prior to amendment of claim 11. For example, new claim 24 calls for providing an on-going count of bits transmitted and time elapsed from the point when the first marker is transmitted. It is respectfully maintained that there are in fact, two on-going counts, one of bits transmitted and the other of time elapsed, both from the point when the first marker is transmitted. This reading of the claim limitation was previously presented in the Reply to Paper No. 6. For example, it was stated that "there are two on-going counts, one of bits transmitted and the other time elapsed...." See Reply to Paper No. 6 at p. 2. This reading of the claim language was again asserted in the Reply to Paper No. 9. See,

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Paper No. 9, p. 2 ("claims 11 and 16 require providing an on-going count of two things, bits transmitted and time elapsed. . .").

As was previously explained, Kenner fails to disclose an on-going count of time elapsed from the point in time where a first marker is transmitted. The absence of a counter supports the assertion that Kenner does not teach an on-going count of time elapsed. That is, once a test packet is sent, there is no suggestion that the transmission of that test packet is tracked in an on-going manner. For example, there is no indication that information regarding the test packet may be obtained before the complete return of the test packet. Thus, Kenner fails to disclose providing an on-going count of time elapsed from the point when a first marker is transmitted.

With respect to Kapoor, it is maintained that Kapoor does not teach an on-going count of bits. Kapoor increments a counter when a data packet is received that has a congestion indicator bit set. Kapoor at column 5, lines 42-52. In other words, if a data packet has the bit set it is counted as one, if not the packet is not counted. Column 5, lines 33-35. Thus, Kapoor teaches an all or none counting. Moreover, as explained above, the count takes place post-transmission. Thus, for at least these reasons, new claim 24 is not believed to be obvious over Kenner in view of Kapoor.

### Conclusion

As explained above, claims 11 and 16 have been amended. The amendments should simplify issues at present. Thus, although after final, the Examiner is requested to enter these amendments. Further, for the reasons explained above, none of the claims are believed to be obvious. Thus, the application is believed to be in condition for allowance. The Examiner's furtherance toward this end is respectfully requested.

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The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0083US).

Respectfully submitted,



Date: January 5, 2004

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